

REMARKS

The Final Office Action mailed March 26, 2007 has been carefully considered.
Reconsideration in view of the following remarks is respectfully requested.

Canceled Claims

Claims 20-22, 31-37 and 39-40 have been canceled without prejudice or disclaimer of the subject matter contained therein.

Rejection(s) Under 35 U.S.C. § 112, Second Paragraph

Claims 1 and 38 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1 and 38 as amended now recite determining if the switch has stored information, and removing such stored information "if the first switch is determined not to be the home agent." The affirmative step of storing information, alleged to be the source of the indefiniteness, has been removed from the claims without prejudice.

Rejection(s) Under 35 U.S.C. § 103 (a)

Claims 1-2, 7-8, 16, 23-24, 29-30 and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rue (U.S. pub. no. 2003/0185172) in view of Lee et al. (U.S. pat. no. 6,535,493). Considering Claim 1 as an exemplary claim, it recites, *inter alia*,

...determining, in response to said receiving, if the first switch has stored information regarding the client;
if the first switch has stored information regarding the client, determining if the first switch is a home agent for the client;
if the first switch has stored information regarding the client and is determined not to be the home agent, removing the stored information regarding the client from the first switch;
tunneling traffic for the client to the second switch if the first switch is determined to be a home agent for the client...

None of these steps are disclosed in Rue. In step S409 of Rue, the second mobile access server 315 broadcasts a Home mobile access server (MAS) Find request message to surrounding

mobile access servers, and, in response, at step S411, the first mobile access 305 server transfers a Home mobile access server (MAS) Find response to the second mobile access server 315 (*see* ¶¶ [0046]-[0047] of Rue). There is no disclosure in Rue of a determination of whether the mobile access server 305 is the home agent for purposes of tunneling traffic therefore to the mobile access server 315 in the manner of the invention. The discussion of tunneling in Rue—that is, in ¶[0035]—is with respect to the prior art disparaged by Rue and allegedly improved upon by Rue’s claimed innovation.

Claims 9-11, 20, 31-33, 37 and 39 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rue (U.S. pub. no. 2003/0185172) in view of Eglin (U.S. pub. no. 2003/0210671).

The Office Action points to Rue’s disclosure of checking a switch for information about a roaming client, and Eglin’s disclosure of multiple VLAN’s serviced by the same switch, and concludes from these disclosures that “it would be obvious that it would be determined whether or not the move request is associated with the client roaming between two virtual local networks serviced by the same switch in said sending,” and that “it would have been obvious to modify Rue, such that it is determined if the move request is associated with client roaming between two virtual local area networks (VLANs) serviced by the same switch by including said first switch in said sending, so that data may appropriately be routed to the roaming mobile node.” Applicants respectfully disagree with both of these obviousness assertions, submitting that they are grounded in impermissible hindsight. Neither Rue nor Eglin disclose provisions for determining whether roaming is between two VLANs serviced by the same switch, as this is simply unnecessary in Englin because of the use of FLAN switches 120. To conclude that a limitation is obvious based on a combination of two references that do not show that limitation clearly fails to rise to the level of a *prima facie* case of obviousness. It will be recalled that according to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.¹

Claims 3-6, 17-19, 25-28 and 36 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rue (U.S. pub. no. 2003/0185172) and Lee et al. (U.S. pat. no. 6,535,493) in further view of Eglin (U.S. pub. no. 2003/0210671). Claim 3 has been amended to recite, *inter alia*, “discovering if the first switch is the same as the second switch by determining if the roam request received by the first switch was also sent by the first switch.” This feature is not disclosed in Rue. The Office Action refers to col. 8, ll. 30-32 of Lee as allegedly showing “discovering if the first switch is the same as the second switch by determining if the roam request received by the first switch was also sent by the first switch.” However, col. 8, ll. 30-32 of Lee, quoted verbatim, reads: “If the mobile unit 100 or 130 determines that its still located at the home subnet, this new AP becomes its new home agent.” No mention of discovery is made, or of a determination of whether the roam request received by the first switch was also sent by the first switch.

Claims 12, 15, 21, 34 and 40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493) in view of Rue (U.S. pub. no. 2003/0185172) and Strachan et al. (U.S. pub. no. 2004/0105440).

Specifically, the Office Action contends that the elements of claim 12 are disclosed in Lee except that Lee does not teach the roam reply having information regarding a client that is roaming to the switch or switching a router designated by the client with a default router for the switch if the handling of the roam request was successful.² The Office Action further contends that Rue teaches the roam reply having information regarding a client that is roaming to the switch and Strachan teaches switching a router designate by the client with a default router for the switch if the handling of the roam request was successful, and that it would be obvious to one

¹ M.P.E.P § 2143.

² Office Action ¶ 4.

having ordinary skill in the art at the time of the invention to incorporate Rue and Strachan into Lee in order to provide a method of enabling seamless roaming of mobile devices among wireless networks. The Applicants respectfully disagree for the reasons set forth below.

The Office Action in appropriately mixes elements of Lee in order to attempt to teach the stated elements of claim 12. Specifically, the Office Action claims that Lee teaches handling a roam reply at a switch and uses Col. 8, lines 13-15 as evidence of this. Col. 8, lines 13-15 describe a foreign agent receiving a roam reply from a home agent. The Office Action then goes on to allege that Lee teaches determining if the roam reply indicates that the handling of a roam request was successful, and uses Col. 9, lines 57-61 as evidence of this. Col. 9, lines 57-61 describe a home agent sending a predetermined code to the foreign agent (which may be used to determine success or failure of the roam request). The Office Action, however, then goes on to allege that Lee teaches sending a reply to a corresponding access point indicating failure if the handling of the roam request was not successful, and uses the same Col. 9, lines 57-61 to support this. This is inappropriate. Either this section of Lee teaches sending a roam reply to the foreign agent or the sending of a reply to a corresponding access point, but not both, as it only teaches a single communication including the predetermined code. The Office Action is attempting to have it both ways, which is inappropriate.

The Office Action further alleges that Rue teaches the roam reply having information regarding a client that is roaming to the switch, and indicates that Rue's inclusion of an internet protocol (IP) address of the client in the roam reply indicates Rue's teaching of this element. Applicant respectfully disagrees, however claim 12 has been amended to make clear that the information that is coming to the switch in the roam reply is information that it does not currently have. It is not meaningless header information such as the IP address of the client, information that it would already have since it sent the roam request. Applicant therefore respectfully submits that claim 12 is in condition for allowance.

Claims 13 and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493), Rue (U.S. pub. no. 2003/0185172) and Strachan et al. (U.S. pub. no. 2004/0105440) and further view of Edney et al. (U.S. pub. no. 2004/0255033).

Claims 13 and 22 depend from claims 12 and 21, respectively, which as discussed above, are patentable over the combination of Lee, Rue and Strachan. Edney fails to remedy the shortcomings of this combination to render obvious claims 12 and 21, and therefore claims 13 and 22 dependent therefrom are patentable over the combination of Lee, Rue and Strachan and Edney.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee et al. (U.S. pat. no. 6,535,493), Rue (U.S. pub. no. 2003/0185172) and Strachan et al. (U.S. pub. no. 2004/0105440) and further view of Eglin (U.S. pub. no. 2003/0210671).

Claim 14 depends from Claim 12, which, as discussed above, is patentable over the combination of Lee, Rue and Strachan. Eglin fails to remedy the shortcomings of this combination to render obvious claim 12, and therefore claim 14 dependent therefrom is patentable over the combination of Lee, Rue and Strachan and Eglin.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rue (U.S. pub. no. 2003/0185172) in view of Lee et al. (U.S. pat. no. 6,535,493) and Edney et al. (U.S. pub. no. 2004/0255033). Claim 35 has been canceled without prejudice or disclaimer of the subject matter contained therein, and the rejection thereof is moot.

Newly-Added Claims

Claims 41-43 have been added to further particularly point out and distinctly claim the subject matter regarded as the invention.

Request for Entry of Amendment

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

Conclusion

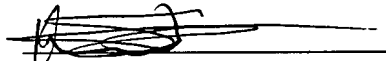
In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

Please charge any additional required fees, including those necessary to obtain extensions of time to render timely the filing of the instant Amendment and/or Reply to Office Action, or credit any overpayment not otherwise credited, to our deposit account no. 50-1698.

Respectfully submitted,
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